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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,079	01/20/2000	David R. Montague	2779.2.2	3921
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PATE PIERCE & BAIRD 175 SOUTH MAIN STREET, SUITE 1250 SALT LAKE CITY, UT 84111			EXAMINER DURAN, ARTHUR D	
			ART UNIT 3622	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/488,079

Applicant(s)

MONTAGUE, DAVID R.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 29-104 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 29-104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/03)
Paper No(s)/Mail Date 5/4/00 6/17/10
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-23, 29-104 have been examined.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/27/10 has been entered.

Response to Amendment

Examiner notes that on 12/31/2009 the BPAI fully affirmed the prior rejection of the claims in this case. Hence, the BPAI decision and all the prior rejections are affirmed as showing is now part of the record on this case.

The Amendment filed on 2/27/10 is insufficient to overcome the prior rejection. Please note the new citations below.

Claim Objections

There are two claims numbered 97. Correction required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 29, and its dependent claims, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to a particular machine or apparatus (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S.

584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. To correct this issue, the independent claim could be amended such that at least one significant feature (not just data gathering or outputting) of the body of the claims actively uses a technological apparatus (computer, server, processor, etc). The attaching or forming steps of claim 29 do not use technological apparatus.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-23, 29-104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dlugos Sr. et al (5,153,842) in view of Redford et al (US2001/0003041).

Claims 1, 11, 18, 29, 47, 68, 79, 92: Dlugos discloses a method and apparatus for attaching product labels comprising:

- a. Affixing a label to a product surface (col 5, lines 48-56);
- b. Configuring the label to provide information corresponding to at least the product and/or source of product (col 3, lines 19-23 and 53-57); and

c. Coupling a computer readable medium containing computer executable instructions (i.e. program) to the label (col 3, lines 39-42 and col 5, lines 48-59).

While Dlugos does not explicitly disclose that the computer executable instructions on the computer readable medium are executable by a computer of the purchaser of the product, Redford discloses a similar method and apparatus of attaching a computer readable medium (optical disk) to an item and further discloses that "on insertion of an optical disk or other such storage media, host device 120 can automatically suspend the display of any current displayed information and automatically start execution of software retrieved from the storage media" (page 7, paragraph 0105). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to store computer executable instructions (software) on the computer readable medium attached to the item in Dlugos. One would have been motivated to include software on the disk to display additional information about the item (e.g. operating instructions, troubleshooting, etc.) or to automatically update the item information stored thereon as discussed by Redford or to provide for automatic registration of the item as discussed by Dlugos.

Examiner notes that on 12/31/2009 the BPAI fully affirmed the prior rejection of the claims in this case. Hence, the BPAI decision and all the prior rejections are affirmed as showing is now part of the record on this case. Hence, the copy of the claims dated 4/12/2005 are fully supported as rejected by Dlugos in view of Redford.

Additionally, on 2/27/10, Applicant filed an RCE with claim amendments. As stated in Applicant's 2/27/10 Remarks, "Claim 1 defines that the computer readable

medium forms part of the label for the product, and where there is first information on the label and second information on the medium. Claims 11 and 18 are similarly amended. None of the prior art showed the computer readable medium forming part of the label."

However, the prior art renders obvious that the computer readable medium forms part of the label for the product, and where there is first information on the label and second information on the medium. As noted above and supported with BPAI affirmation dated 12/31/2009, the prior art discloses a label on a product and a computer readable medium. And, Redford further discloses that the computer readable medium or CD-ROM can have text on it that functions as a label (Figs. 5g, 5i; and following citation): "[134]...In this implementation, CD-ROM 544 has printed content (e.g. text) that uniquely identifies to the user the identity of booklet 540 to be used with CD-ROM 544. For example, each of CD-ROM 544 and booklet 540 may have the same title, such as "FRED, THE FIRE ENGINE"". And, Dlugos would be motivated to have a label on the CD-ROM for similar reasons as stated above and priorly. Also, Dlugos would better want to know what the CD-ROM is for and that the CD-ROM is associated with the product so the user can better use the product and CD-ROM.

Also, in regards to claim 68, Redford discloses a sleeve (Figs. 5g, 5i). Also, in regards to claim 79, Redford further discloses a disk in non-circular shape (Figs. 5g, 5i). Redford further discloses a disk in a holder or sleeve (Figs. 5g, 5i).

Also, the following is in further regards to claim 18. Dlugos does not explicitly disclose a hanging tag or tag attached by a tether to the product. However, Dlugos

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further discloses that the label may be attached in various ways to a wide variety of products (col 5, line 48 - col 6, line 23). Dlugos further discloses that the label or tag can be a variety of sizes (col 6, lines 11-23). Redford further discloses the label being a variety of sizes and attached in a variety of ways (Figs. 4a, 5f, 5g, 5i). And, Applicant's Specification (PG_Pub version) states that it is old and well known that hanging tags or tags attached with tethers can be attached to some types of products:

“ [0057] As a practical matter, the penetrations 76 may be provided with tethers 75 for connecting a CD-ROM 60 to various products. For example, in the clothing industry, various types of tethering mechanisms have been developed to facilitate automatic insertion of securement mechanisms with minimum labor and minimum cost. Nevertheless, alternative embodiments may operate independent of the tethers 75.

[0116] Referring now to FIG. 10 another embodiment of the invention is presented as a user-computer-readable medium imbedded in a product label 410 (herein the label). The label 410 may be configured to be a hang tag as the term is used in the clothing and retail industries, any hanging tag configured to be attached to a product using a tether 75, or any tag configured to be attached to a product in any other manner.

[0117] Penetrations 76 may be provided with tethers 75 for connecting a label 410 to various products. For example, in the clothing industry, various types of tethering mechanisms have been developed to facilitate automatic insertion of securement mechanisms with minimum labor and minimum cost.

Nevertheless, alternative embodiments may operate independent of the tethers 75."

Hence, Applicant states that it is old and well known that hanging tags can be attached to certain types of products. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add hanging tags to Dlugos variety of tag sizes, types, and attachment methods for a variety of products. One would have been motivated to do this in order to better have an appropriate tag for different products.

Also, in further regards to claim 92, Dlugos does not explicitly disclose pressure fit in the center of the disk. However, Redford discloses a disk with a center and the standard pressure fit holders on CD-ROM/ DVD disks (Fig. 5g). Redford further discloses removing the disk ([99, 104, 105]) and also the use of pressure related to disk or information retrieval operations ([10]). Hence, it is obvious that the standard pressure holder part of a CD-ROM/DVD in Redford can be utilized for holding the disk to Dlugos' package. One would be motivated to do this because the pressure holder is already there and a convenient and intended way to hold a disk.

Claims 2, 19, 30, 44, 48, 63 -67, 69, 70, 80, 84, 97 : Dlugos and Redford disclose an apparatus for attaching product labels as in Claims 1, 11, and 18 above, and Dlugos further discloses the information is printed on the label (col 3, lines 19-23). Also, Redford discloses info on the disk (see rejection above). Dlugos further discloses that the label is attached to the outside of the product using a flexible member (i.e. the label is a tag)(col 5, line 60 - col 6, line 2). Redford also discloses a flexible tag or flexible attachment member (Figs. 5g, 5i). Dlugos further discloses the product is in a

package (Figs. 4, 5 and associated text descriptions in Spec). Also, It is inherent that since the label in Dlugos is on the outside of the product, it is viewable by the prospective purchaser or anyone else who looks at the product.

Claim 3, 8, 13, 16, 20: Dlugos does not explicitly disclose a hanging tag.
However, please see the rejection of claim 18 above.

Claim 4, 12: Dlugos further discloses that the product is packaged with a "clear plastic film " (col 5, lines 49-51). Redford also discloses clear film or see thru packaging (Figs. 5g, 5i).

Claim 5: Dlugos discloses information on the label as shown in rejection above.

Claim 6: Redford discloses the medium is removable (Figs 5g, 5i).

Claim 7: See rejection of independent claim above.

Claims 9 and 17: Dlugos and Redford disclose an apparatus for attaching product labels as in Claims 1 and 11 above, and Dlugos further discloses that the computer readable medium includes a printed medium or an electromagnetic medium (col 3, lines 19-23 and 39-52).

Claim 10: Moos and Redford disclose an apparatus for attaching product labels as in Claim 9 above, and Dlugos further discloses that the computer readable medium is formatted as a bar code or embedded chip (col 3, lines 12-13, col 4, lines 52-57, and col 4, line 67 - col 5, line 8).

Claims 14, and 21: Dlugos and Redford disclose an apparatus for attaching product labels as in Claims 1, 11, and 18 above. While Dlugos prefers that the label is the same size and shape as a credit card, it is also disclosed that the label "may be of

an overall shape or size different from the standard credit card" (col 6, lines 11-23).

However, Dlugos does not explicitly disclose using a trademark symbol on the label to identify the product or the source of the product. Official Notice is taken that it is old and well known within the marketing arts to use trademark symbols to identify both products and product sources; indeed, that is the purpose for registering trademarks. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a trademark symbol on the label in Dlugos. One would have been motivated to include a trademark symbol on the label in order to facilitate quick and easy identification of the product and its source.

Claims 15, and 22, 39, 40-43, 57-62, 76-78, 81, 82, 93, 94: Dlugos and Redford disclose an apparatus for attaching product labels as in Claims 1, 11, and 18 above, and Dlugos further discloses the computer readable medium containing information pertaining to product facts, source facts, data gathering interface, and many other types of information for use by the receiver, sender, and/or shipper (col 9, lines 49-62). Redford further discloses a disk in non-circular shape (Figs. 5g, 5i). Redford further discloses a disk in a sleeve (Figs. 5g, 5i).

Claim 45: See claims 2 and 4 above.

Claim 46: Redford discloses directly attaching (Figs. 5g, 5i).

Claim 23: Dlugos and Redford disclose an apparatus for attaching product labels as in Claim 18 above. While various methods of attaching the label to the product are disclosed, including inserting the label into a small pouch, using clips or brackets, etc., it is not explicitly disclosed that the opening into which the label is inserted penetrates all

the way into the interior of the product. However, it would have been obvious that such a method of attachment could be used, depending upon the actual product, of course. One would have been motivated to use this or other methods to attach the label to the product in order to prevent or reduce the likelihood that the label would become detached during shipping or handling as discussed by Dlugos.

Claim 31-34, 49-52, 71, 83, 86-88, 95, 96, 98-100: Redford discloses a sleeve (Figs. 5g, 5i).

Claim 85, 89: Redford further discloses a disc with a round center part (Fig. 5g). Hence, it is obvious that the round center part can be used for a variety of practical things such as securing the disk. One would do this because the center part is commonly used to secure disks in CD cases, etc. Also, see the rejection of claim 92 above.

Claims 35-38, 53-56, 72-75, 90, 91, 93, 101-104: Redford discloses a disk with further and varied information related to the product and also the ability to access more information related to the product ([11, 87, 88]; Fig. 3c).

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are not found persuasive. Please see the new citations above. Also, note the following.

Examiner notes that on 12/31/2009 the BPAI fully affirmed the prior rejection of the claims in this case. Hence, the BPAI decision and all the prior rejections are affirmed as showing is now part of the record on this case. However, Applicant has filed an RCE on 2/27/10 with claim amendments and also new claims.

On page 26 of Applicant Remarks dated 2/27/10, Applicant states:

"Claim 1 defines that the computer readable medium forms part of the label for the product, and where there is first information on the label and second information on the medium. Claims 11 and 18 are similarly amended. None of the prior art showed the computer readable medium forming part of the label."

However, the prior art renders obvious that the computer readable medium forms part of the label for the product, and where there is first information on the label and second information on the medium. As noted above and supported with BPAI affirmation dated 12/31/2009, the prior art discloses a label on a product and a computer readable medium. And, Redford further discloses that the computer readable medium or CD-ROM can have text on it that functions as a label (Figs. 5g, 5i; and following citation): "[134]...In this implementation, CD-ROM 544 has printed content (e.g. text) that uniquely identifies to the user the identity of booklet 540 to be used with CD-ROM 544. For example, each of CD-ROM 544 and booklet 540 may have the same title, such as "FRED, THE FIRE ENGINE"". And, Dlugos would be motivated to have a label on the CD-ROM for similar reasons as stated above and priorly. Also, Dlugos would better want to know what the CD-ROM is for and that the CD-ROM is associated with the product so the user can better use the product and CD-ROM.

Please see the added citations in the rejection of the claims above and also the rejection of the new claims above.

Hence, the prior art combination renders obvious the Applicant's claims.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a. Lanpher et al (5,333,106) discloses a method and apparatus for attaching a data storage device to a product which contains computer readable instructions to enable the user to learn and monitor the correct usage of an aerosol pharmaceutical product.

b. Grundy (5,375,240) discloses a method and apparatus for distributing information on a machine readable medium which includes executable instructions for registering the software on the machine readable medium.

c. Redford et al(5,711,672) discloses a method and apparatus for automatically starting the execution of computer readable instructions stored on a storage media which automatically copies a new version of the software into the storage media.

d. Tycksen, Jr. et al (5,898,777) discloses a method and apparatus for disseminating digital products storing a plurality of software programs as packages.

e. Ronning (5,907,617) discloses a method and apparatus for distributing software on a storage media which also contains executable instructions for tracking and reporting the number of times the software was used.

f. Takahashi et al (6,195,432) discloses a method and apparatus for distributing software on a storage media which contains executable instructions for downloading updated and full versions of the software.

g. Fuller et al (6,216,112) discloses a method and apparatus for distributing software on a storage media which also including executable instructions for retrieving and presenting advertisements to the user.

h. Collart (6,405,203) discloses a method and apparatus for preventing unauthorized use of the contents on a storage media by executing stored instructions to retrieve authorization (and codes) from a remote device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571)272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Arthur Duran
Primary Examiner
Art Unit 3622

/Arthur Duran/
Primary Examiner, Art Unit 3622
3/23/2010